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Our Case No. 9799940/0010
Cypress Ref. No. PM95029(2)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of James M. Cleeves

Serial No. 08/581,347

Filing Date of December 29, 1995

For: WAFER TEMPERATURE CONTROL APPARATUS AND METHOD

Appeal no. 2003-1081

BOARD OF PATENT APPEALS & INTERFERENCES
OCT - 7 2003

RESPONSE TO NEW GROUND OF REJECTION UNDER 37 CFR 1.196(B)

M.S. - AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the new ground of rejection entered under 37 CFR 1.196(b) Applicant respectfully requests reconsideration of the present application in light of the following remarks.

Request For Reconsideration

The rejection of the claims under 35 USC 112, second paragraph, is respectfully traverse. As evidence by the attached Declaration under 37 CFR 1.132, the metes and bounds of the claimed invention are clear to one of ordinary skill in the art.

The test for assessing whether a claim meets the definiteness requirement is "whether one of ordinary skill in the art would understand the bounds of the claim when read in light of the specification." *LNP Eng'g Plastics, Inc. v. Miller Waste Mills, Inc.*, 275 F.3d 1347, 1359 (Fed. Cir. 2001); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1342 (Fed. Cir. 2003) (holding that "[a] claim is indefinite if, when read in light of the specification, it does not reasonably apprise those skilled in the art of the scope of the invention"); *Exxon Research Eng'g Co. v. United States*, 265 F.3d. 1371, 1375 (Fed. Cir. 2001) (holding that the court has "not insisted that claims be plain on their face in order to avoid condemnation for indefiniteness; rather, what [the court] ha[s] asked is that the claims be amenable to construction, however difficult that task may be"); *Seattle Box Co., Inc. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826 (Fed. Cir. 1984); *In re Mattison*, 509 F.2d 563, 565 (C.C.P.A. 1975) (reversing the Board of Appeals rejection of claim language as being indefinite under § 112, ¶2 because one of ordinary skill in the art would be able to determine the scope of the claimed language in terms of a specific value)

The term "substantially" is definite, if one of ordinary skill in the art would understand the bounds of the claim when read in light of the specification. In *LNP Engineering Plastics*, the court held that even though the term "substantially completely wetted" is not defined in the specification of the patent, the written description and testimony of both parties confirmed that experts assess wettedness by a variety of criteria, including specific tests set forth in the claim found definite by the district court. The reviewing court affirmed the district court's finding that the claim language was not indefinite because the tests and the full disclosure in the patent inform one of ordinary skill in the art of the bounds of the claim. *Id.* at 1360. The Federal Circuit has reached similar conclusions about the definiteness of the term "substantially" in other cases. *See Seattle Box Company*, 731 F.2d at 826 (affirming the district court's holding that the term "substantially equal to" is definite claim language becaus an expert would know the limitations of the claims in light of the specification).

The Federal Circuit considers it "well established" law that the term "substantially" is not indefinite when the term "serves reasonably to describe the subject matter so that its scope would be understood by persons in the field of the invention, and to distinguish the claimed subject matter from the prior art." *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1120 (Fed. Cir. 2002). In *Verve*, the district court granting summary judgment of invalidity on a patent because the use of the phrase "substantially constant wall thickness" rendered claim 1 of a patent indefinite under 35 U.S.C. § 112, ¶2. *Id.* at 1119. The district court recognized that the usage of "substantially" may be adequately definite in some cases, but that it was indefinite because it was not further defined. *Id.* The Federal Circuit vacated the district court's summary judgment of invalidity because the lower court erred in law in requiring intrinsic evidence of the specification and the prosecution history as the sole source of the meaning of language in a technical sense. *Id.* As the court pointed out, "[t]he question is not whether the word 'substantially' has a fixed meaning as applied to 'constant wall thickness,' but how the phrase would be understood by persons experienced in this field of mechanics, upon reading the patent documents." *Id.* at 1119-1120.

Applicant provides herewith a Declaration under 37 CFR 1.132 by Krishnaswamy Ramkumar. In this Declaration, Krishnaswamy Ramkumar provides statements indicating that he was a person in the field of the present invention, at the time of filing of the present application. He further states that he, as well as others in the field, would have understood the phrases "transferring heat . . . substantially uniformly across said substrate . . ." and "substantially uniform heat transfer across said substrate" to mean that the temperature of the substrate would be uniform enough that the etching of different parts of the substrate would not be uncontrollable, or in other words a temperature differences across the substrate of less than 10 degrees Celsius. Similarly, he as well as others in the field, would have understood the phrase "said substrate has a substantially uniform temperature" to mean that the temperature differences across the substrate would be less than 10 degrees Celsius.

The "resolution of any ambiguity arising from the claims and specification may be aided by extrinsic evidence of usage and meaning of a term in the context of the invention." *Verve, LLC*, 311 F.3d at 1119. In *Verve*, the Federal Circuit held that,

although intrinsic evidence is the primary source for interpreting claims, courts are instructed to use any reliable source that informs as to the meaning of claim language. *Id.* As the court emphasized, "the criterion is the meaning of words as they would be understood by persons in the field of the invention." *Id.* Accordingly, the Declaration by Krishnaswamy Ramkumar is acceptable extrinsic evidence of usage and meaning of a term in the context of the invention. Applicant submits that the evidence, taken as a whole, indicates that the metes and bounds of the claims would be clear to one of ordinary skill in the art, at the time of filing. Withdrawal of this ground of rejection is respectfully requested.

Applicants submit the application is now in condition for allowance. Early notice of such action is earnestly solicited.

Respectfully submitted,

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